



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/489,515	01/21/2000	Surya Prakash	06618-408001	5938

20985 7590 08/04/2006

FISH & RICHARDSON, PC
P.O. BOX 1022
MINNEAPOLIS, MN 55440-1022

EXAMINER

MERCADO, JULIAN A

ART UNIT	PAPER NUMBER
----------	--------------

1745

DATE MAILED: 08/04/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

8

Advisory Action Before the Filing of an Appeal Brief	Application No. 09/489,515	Applicant(s) PRAKASH ET AL.	
	Examiner Julian Mercado	Art Unit 1745	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 05 July 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: 19-22, 24-27 and 29-33.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☐ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____.
13. ☒ Other: see attached.


PATRICK JOSEPH RYAN
SUPERVISORY PATENT EXAMINER

Advisory Action

Applicant's remarks after Final will be entered upon filing of a Notice of Appeal and an Appeal Brief. Arguments submitted therein have been fully considered, however they are not found persuasive for the following reasons.

Regarding Prakash not teaching a catalyst ink that contains PVDF, it appears to the examiner that applicant differentiates claim 26 from Prakash insofar as the patentee "discloses catalyst electrodes...", while at the same time conceding that "the membrane is partially comprised of PVDF...." However, any distinction drawn to the catalyst ink being a part of the electrode or a part of the membrane is irrelevant, as the claim calls for a "membrane electrode assembly". As to Prakash providing no motivation to use PVDF in the catalyst ink, it appears to the examiner that this argument is premised on a proposed *modification* of the membrane of Prakash, which in and of itself is PVDF. There is *no modification* proposed for Prakash. Applicant is reminded that the extent to which a 35 U.S.C. 103(a) rejection is made based on Prakash is solely to the extent that the claimed product appears to be the same or similar to the prior art product, i.e. the claimed product comprises PVDF, while the prior art product also comprises PVDF. With respect to the asserted differences between the claimed fuel cell and the prior art fuel cell as summarized in the paragraph bridging pages 5-6, in reply the examiner maintains that the prior art fuel cell in terms of these alleged differences is the same as that claimed by applicant insofar as the prior art fuel cell also exhibits low methanol crossover rates (equal to the alleged "low intrinsic permeability to methanol" of the claimed invention) and improved electrode/membrane interface characteristics (equal to the alleged "improved

Art Unit: 1745

interfacial bonding characteristics of the claimed invention”). See col. 3 line 33 et seq. and col. 7 line 46 et seq.

Regarding Fleisher et al., arguments drawn to what applicant’s specification may disclose, e.g. to what extent the membrane does not swell significantly in water, are not considered relevant to the claims which are not found commensurate in scope. Notwithstanding, the extent to which the disclosed membrane does not swell *significantly* is unclear. As to there being no suggestion for the combination with Grot et al., refer to the prior Office action on page 4. With respect to the proposed modification eliminating Grot’s basic principle of operation, this argument is not persuasive as there is no basis for expectation that the combined teachings would be inoperative. In fact, the examiner is of the position that Grot’s teaching of an inorganic filler would *enhance* the desired lower rate of methanol crossover. (for, e.g., the reasons provided for by applicant on page 8)

It is noted that arguments submitted for Kindler, Cabasso et al. and Lawrance et al. merely assert that these reference fail to remedy alleged differences of the primary and secondary references maintained above.

Conclusion

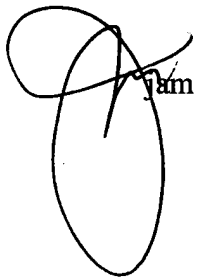
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Julian Mercado whose telephone number is (571) 272-1289. The examiner can normally be reached on Monday through Friday.

Art Unit: 1745

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patrick J. Ryan, can be reached on (571) 272-1292. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

A handwritten signature in black ink, consisting of a large, stylized loop followed by a vertical stroke and a horizontal stroke. The signature is positioned in the lower-left corner of the page.